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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,672	10/30/2003	Steven W. Trovinger	10015154-3	3549

7590 09/22/2004

HEWLETT-PACKARD COMPANY
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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/698,672	Applicant(s) ON TROVINGER, STEVEN W.	
	Examiner Mark T Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1-13, 20 and 21 have been canceled.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 14-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-19 of copending Application No. 10/084,462. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a pivotable collecting device and a method of transferring folded sheet material comprising: a supporting edge for supporting a fold of the folded sheet material; two supporting sides opposing one another; a means for pivoting the supporting edge about a first axis to receive the folded sheet such that each supporting side receives a different portion of the folded sheet material; a collecting drive for clamping the folded sheet material against the supporting side and advancing the sheet material along at least one side supporting side; wherein the collecting drive is rotatable.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lehmann et al (5,810,345).

Lehmann et al discloses in Fig. 1-3, a pivotable collecting device and a method for transferring folded sheets comprising: a supporting edge (8) for supporting a fold (7) of a folded sheet material; two oppositely-parallel supporting sides (4a and 4b); and a means (5) for pivoting the supporting edge (14a) about a first Z-axis to receive the folded sheet material (6) such that each supporting side (4a and 4b) receives a different portion (9 and 10) of the folded sheet material; wherein the first Z-axis is parallel to a longitudinal axis (L1) of the supporting edge; pivoting the collecting device in a first direction (A) such that a side of the collecting device

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receives a portion of the sheet material, and wherein a receiving step includes pivoting in a second direction (B) to receive the other portion of the folded sheet.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinhen (5,615, 871) in view of St. Denis (4,083,551).

Kleinhen discloses in Fig. 5, a collecting device (22 and 190) and a method for transferring folded sheet material comprising: receiving a first portion (14a) of a folded sheet material (14) on a first supporting side (22b) of a collecting device (22); supporting a fold (14c) on a supporting edge (22a); a means on the collecting device in which to receive the folded sheet such that each supporting side (22b and 22c) receives a different portion (14a and 14b) of the sheet material; wherein the two parallel supporting sides (22b and 22c) opposing one another; a means (190) for deflecting the folded sheet material onto at least one of the supporting sides.

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However Kleinhenn does not disclose a means for pivoting the supporting edge and sides about a first axis to receive the folded sheet.

St Denis discloses in Fig. 2 and 4, a pivotable collecting device comprising a means (16) for pivoting the supporting edge (14a) about a first Y-axis to receive the folded sheet material such that each supporting side (14b and 14c) receives a different portion (S1 and S2) of the folded sheet material.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kleinhenn's method for transferring folded sheet material with a method of pivoting the collecting device as taught by St. Denis for the purpose of allowing the collecting device to repeat its function of collecting booklets.

Prior Art References

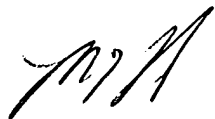
The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Trovinger, Trovinger ('061), Trovinger ('267), Trovinger ('644), Trovinger ('756), Trovinger ('705), Boss, Hartsoe, Muller, Hansch, Honnegger, Hartmann et al, Trovinger ('583), Lehmann et al, Mandel et al, Cruz et al, Horii et al, Boss et al, Cracknell, Stauber, Hansch (148), Honegger ('108), Moser, Moser ('141), Reist, Glanzmann, McCain et al, Honegger ('110), Trovinger et al ('304), Trovinger et al ('302),

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Schlough, Mowry et al, Auksi, Samuels, Hansch ('666), Hansch ('667), Hansch ('926), Honegger ('014), Honegger ('033), Meier, and Meier et al disclose similar pivotable collecting devices.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

September 15, 2004



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